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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 09/913,992   | 03/21/2002  | Rodolfo Mann Pelz      | 10191/1969          | 8032             |
| 26646 7590 02/04/2009<br>KENYON & KENYON LLP<br>ONE BROADWAY<br>NEW YORK, NY 10004 |             |                        |                     |                  |
| EXAMINER<br>WEST, JEFFREY R  |             |                        |                     |                  |
| ART UNIT<br>2857   |             | PAPER NUMBER           |                     |                  |
| MAIL DATE<br>02/04/2009  |             | DELIVERY MODE<br>PAPER |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

09/913,992

**Applicant(s)**

PELZ ET AL.

**Examiner**

Jeffrey R. West

**Art Unit**

2857

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Jeffrey R. West/  
Primary Examiner, Art Unit 2857

With respect to Applicant's argument that "one of ordinary skill in the art would be able to implement the claimed subject matter without undue experimentation", the Examiner maintains the rejection of independent claims 11 and 19 as failing to comply with the enablement requirement. Specifically, by providing claims that require both "performing an error diagnosis of software running on the other components" and "allowing a remote diagnosis of the other components of the distributed system to be carried out, wherein the remote diagnosis includes testing at least one of the other components", one having ordinary skill in the art would not be able to perform both remote testing and remote diagnosis without undue experimentation as one having ordinary skill in the art would consider testing and diagnosis to often cover the same thing and therefore would turn to the specification for clarification. The specification, however, does not mention any steps to be carried out regarding the test and makes it unclear to one having ordinary skill in the art how the remote diagnosis and testing differ and raises the issue as to whether or not the remote diagnosis and testing are indeed different from each other, refers to the testing as being performed by the local service element, and not by a remote means, thereby making it unclear to one having ordinary skill in the art whether this testing is considered to be the remote testing, and discusses the testing as testing the new software version for errors making it unclear whether the discussed testing of the new software version for errors is with reference to the claimed "performing an error diagnosis of software running on the other components" or "remote...diagnosis of the other components".

With respect to Applicant's argument that page 2, lines 13-30 of the specification adequately support the limitations of claim 26, the Examiner agrees with Applicant that "a service provider to perform a remote diagnosis" does not preclude "the service element...[performing] an error diagnosis...", but maintains that this section does not support all of, "a processing device disposed in the motor vehicle and adapted to perform operations including the operations of: automatically, and at predefined intervals, performing an error diagnosis of software running on the other components; for each of a first subset of errors diagnosed in the error diagnosis step, repair the error; and for each of a second subset of errors diagnosed in the error diagnosing step, contact a provider and allow the provider to responsively remotely repair the error" for the reasons provided in the Final Office Action.

With respect to Applicant's argument that "neither Razavi nor de Bellefeuille disclose the feature of 'performing an emergency function'", the Examiner maintains that column 1, lines 41-46 of Razavi refers to emergency assistance signaling as one particular delivery of services to the user which are described throughout the disclosure as network-based services (see, for example, column 5, lines 9-35) and are also described as being performed by a processing device, along with a map service, in column 7, lines 54-63.

In response to Applicant's argument that Razavi does not teach "configuring" or "maintaining", the Examiner draws Applicant's attention to the Arguments filed November 13, 2007, wherein, in response to a lack of enablement regarding the "maintaining" operation due to the fact that the disclosed "maintaining" is actually "upgrading", Applicant amended the claims to delete a separate reference to "upgrading". As such, the Examiner maintains that the cited column 13, lines 53-61 and column 15, lines 6-13 of Razavi discloses the claimed maintaining, specifically, since column 13, lines 53-61 and column 15, lines 6-13 of Razavi explicitly discloses upgrading the software of the components of the network by downloading new software through a network and column 6, lines 10-35 and column 8, lines 21-29 and 50-67 discloses that it is the processing device that handles software execution and communication. Additionally, column 7, lines 40-46, column 8, lines 21-29, and column 11, lines 14-20 disclose the claimed "configuring" by controlling the software execution by the processing device to change the operation of the other components.

The Examiner also notes that claim 14 explicitly further limits the maintaining to include "communicating with a communication element for loading new software for the other components".

In response to Applicant's argument that "nowhere does Gray disclose a service element that maintains other components as provided for in the present claims", the Examiner again notes that in the Arguments filed November 13, 2007, in response to a lack of enablement regarding the "maintaining" operation due to the fact that the disclosed "maintaining" is actually "upgrading", Applicant amended the claims to delete a separate reference to "upgrading". The Examiner further asserts that nothing in the claims requires downloading/installing anything to the individual components, and therefore that using a broadest reasonable interpretation of the claimed "maintaining other components", Gray explicitly discloses upgrading/maintaining the interfaces of the other components by receiving software upgrades/updates via a port of the vehicle control center and, as such, the vehicle control center (i.e. service element) in Gray performs the operation of maintaining the other components.

In response to Applicant's argument regarding "the remote diagnosis includes testing at least one of the other components", the Examiner first asserts that this limitation is only being rejected "as may best be understood" due to the lack of enablement. Additionally, the Examiner maintains that Chou discloses remote diagnosis including testing by disclosing a diagnostic server that receives "test data with time-stamp" for determining whether "the vehicle is in good health with no urgent action required, or that one or more problems requiring immediate attention are detected".

/JRW/